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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,347	12/07/2001	Miwa Kozawa	100021-00065	8095

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EXAMINER

PENG, KUO LIANG

ART UNIT PAPER NUMBER

1712

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/005,347	Applicant(s) KOZAWA ET AL.	
	Examiner Kuo-Liang Peng	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/9/05 RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 and 18-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 18-21 is/are allowed.
- 6) ☒ Claim(s) 2,3 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

nd

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on May 9, 2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-3 and 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 2, it is confused that in the silicon-containing polymer, at least some of the X groups are triorganosilyl groups must be triorganosilyl groups. However, "n" can be 0. It appears that in the amendment filed on April 9, 2004,

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“n” was inadvertently not updated to reflect that at least some of the X groups are triorganosilyl groups. Therefore, Applicants are advised to specify that “n” is a positive integer.

In Claim 5, it is confused that $(O_{1/2}Si(R^1)_2-R^2-COOR^7)$ units can be the same as $(O_{1/2}Si(R^1)_2-R^2-COOR^8)$ units.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 5-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (US 3 741 435).

Miller discloses a filler of silica gel (i.e., containing $SiO_{4/2}$), etc. which is surface treated with a carboxylalkenyl trihalosilane. (col. 2, line 45 to col. 3, line 50 and col. 5, lines 1-39) Note that when R^7 is the same as R^8 , the corresponding p and q in the instant treated filler can be properly chosen in order to satisfy $0.1 < q/(1 + n + p + q) \leq 0.8$.

6. Claims 5-6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishihara (JP 08-325276).

Nishihara discloses a filler of silica (i.e., containing $\text{SiO}_{4/2}$), etc. which is surface treated with a carboxylalkenyl trihalosilane. (Abstract, [0010]-[0020], [0029]-[0033] and Examples) Note that when R^7 is the same as R^8 , the corresponding p and q in the instant treated filler can be properly chosen in order to satisfy $0.1 < q/(1 + n + p + q) \leq 0.8$.

7. Claims 2-3 and 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

None of Miller and Nishihara teaches or fairly suggests a) at least some of the X groups being triorganosilyl groups set forth in Claims 2-3; and b) the specific R^8 set forth in claim 7.

Allowable Subject Matter

8. Claims 4 and 18-21 are allowed.

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9. The following is an examiner's statement of reasons for allowance:

The present claims are allowable for at least the following reason(s) over the closest references: Miller and Nishihara.

None of these references teaches or fairly suggests a) the polymer containing the units of $O_{1/2}SiR^4R^5R^6$ having at least one organic group containing chloromethylphenylethyl set forth in Claims 4; and b) the polymer containing the units of both $O_{1/2}SiR^1_2R^2COOH$ and $O_{1/2}SiR^1_2R^2COOR^3$ set forth in Claims 18-21.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

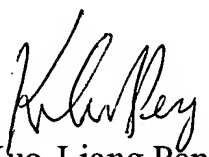
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
May 23, 2005



Kuo-Liang Peng
Primary Examiner
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